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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,765	02/13/2001	Kelli Hodge Kennedy	10005680-1	9673
22879 7590 12/11/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			12/11/2008	ELECTRONIC

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/782,765
Filing Date: February 13, 2001
Appellant(s): KENNEDY ET AL.

SCOTT LUNI
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 12th, 2006 appealing from the Office action mailed September 21st, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is not correct. This Examiner's Answer contains a new ground of rejection.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

6,931,454	TE et al	08-2005
6,216,141	STRAUB ET AL	04-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Straub et al (U. S Patent No 6,216,141) in view of Ta et al (U.S. Patent No 6,931,545).

3. As per claims 1, 9, 10, 19, Straub et al teach a method of distributing a document of a user, the document including at least one of textual and graphical information, the method comprising registering document distribution services of a plurality of document distribution providers with a document distribution system controller, the document distribution services including at least one of print services, electronic mail services, and publishing services; receiving a distribution request for the document from the user at the document distribution system controller, compiling a list of distribution options for the document with the document

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distribution system controller based on the document distribution services of the document a distribution providers, and presenting the list of distribution options for the document to the document provider (*see abstract, figs 1, 3, 4, 7, 11, 12 and their accompanied text, and column 2 lines 29-3 lines 67, 9 lines 9-46*). Straub et al fail to teach wherein the user provides the content to the system for distribution. However, Ta et al teach a system/method wherein the user provides the content to the system for distribution (*see column 5 lines 11-6 line 22*). Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to modify the invention of Straub et al to include Ta et al's system/method wherein the user provide the content to the system for distribution because this would have ensure that users' content is properly distributed.

4. As per claims 3-7, 11-17, 21 and 23-27 and 30, they disclose the same inventive concept as claims 1, 9, 10 and 19. Therefore, they are rejected under the same rationale.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 101

Claims 1, 3-7, 19, 21, and 23-25 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such

¹ See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

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as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, the claim(s) fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

(10) Response to Argument

Claim Mapping

Broadest Claim 1,

Limitation	Art Straub 6,216,141	Art Ta et al 6,931,454
A method of distributing a document of a user, the document including at least one of textural and graphical information,	a client computer connects to a computer network, and retrieves a "main" channel guide containing a list of content providers from which a user can select one or more content providers. Based on the user's selections, the client computer retrieves one or more documents associated with a content provider selected from the channel guide. The one	A content provider, such as a document publisher or distributor, provides, for example, protected content to a user, for consumption within a trusted user environment. (<i>abstract</i>)

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	or more documents are then integrated into the desktop window on the client computer. (<i>column 3 lines 18-26</i>)	
registering document distribution services of a plurality of document distribution providers with a document distribution system controller, the document distribution services including at least one of print services, electronic mail services, and print publishing services;	The AddProvider function adds the selected content provider to the user-preference storage when the user selects a content provider from the channel guide. A URL is stored in the channel guide for each content provider and allows the client computer to connect to a server computer associated with the content provider (<i>see column 12 lines 10-15</i>).	
receiving a distribution request for the document from the user at the document distribution system controller	the user may customize which documents are displayed from a selected content provider. A user selects a content provider and a list of document preferences associated with the selected content provider are displayed. (<i>see column 3 lines 27-31</i>).	
compiling a list of distribution options for the document with the document distribution system controller based on the document distribution services of the document distribution providers	The user may then select the desired document preferences. Each document preference selected results in the display of one or more documents related to that preference (<i>see column 3 lines 31-35</i>).	
presenting the list of distribution options for the document to the user,	Selecting the options button results in the opening of an options window having a menu of options the user can select. For example, the user can select an option. Additionally, the user can select the duration that each document or channel is displayed. The user can also access a channel guide (sometimes referred to as a catalog) that allows the user to select channels and documents displayed in the viewer 140 In other words, a user can add to or delete, from the list of currently selected channels in the channel bar, a	

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	content provider or topic of information. (see column 9 lines 9-22).	
wherein the user provides the document to the document distribution system controller		a content provider and distributor 300 provides digital content, such as a document, to a user system 400. The user system 400 comprises one or more system components such as hardware components and/or various software applications (see column 5 lines 29-33).

Applicant's argue that the prior arts Straub et al. patent taken alone or in combination with Ta et al cannot be considered a user as recited in independent claims 1, 9, 10, 19, 26, and 27 because the one or more content providers of the Straub et al. patent are not presented with nor do they make a selection of distribution options for the document. Alternatively, the actual user of the system and method of the Straub et al. patent cannot be considered a user as recited in independent claims 1, 9, 10, 19, 26, and 27 because the user of the system and method of the Straub et al. patent is not the party providing the document. According to Applicant the Examiner recognizes that the Straub et al. patent "fail[s] to teach wherein the user provides the content to the system for distribution." Therefore, Applicants argue that the Ta et al. patent provides that "a content provider and distributor 300 provides digital content, such as a document, to a user system 400". As such, the Ta et al. patent provides that during the course of use, "the user 400 would request from the content provider 300 one or more documents, such as an electronic book, a multimedia file, a presentation, a form template, or the like" whereby upon receiving the request, "the content provider and distributor 300 could provide the requested content in protected form with a profile identification 10 to the end user 400". Thus, with the

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system of the Ta et al. patent, according to the Applicant the content provider 300 is the entity providing the content (i.e., one or more documents) while the user 400 is the entity requesting the content from the content provider 300.

Examiner respectfully disagrees with Applicant characterization of the prior arts in independent claims 1, 9, 10, 19, 26, and 27, applicant disclose a system and method wherein among other things the user of the system provides the document to the document distribution system. From Examiner perspective, a content distribution system usually comprises a distribution entity, a user entity and a content provider entity. Generally the content provider provides content to the system and the user request content from the system. In the Applicant claims there is only one entity that provide and request content to and from the distribution system. Therefore, when the entity/party requests content from the system, it acts as a user and when the same entity/party provides content to the distribution system, it acts like a provider. Therefore the user is the same as the provider providing content to the system. It is obvious that in Ta et al system, as acknowledged by the Applicant and also it is well know in the art, any party attached to a system a user of the system. Therefore, since the Ta et al patent provides that "a content provider and distributor 300 provides digital content, such as a document, to system 400", the content provider of Ta et al's system is a user of the system that provides content to the system. Examiner respectfully disagrees with the Applicant that the party in Ta et al's patent cannot be considered a user as recited in independent claims 1, 9, 10, 19, 26, and 27 because the it only provides content to the system.

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(11) Related Proceeding(s) Appendix

There are no related proceedings

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).


Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent

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applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Joshua Murdough


ANDREW J. FISCHER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR

